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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,089	02/05/2004	Michael R. Farzan	7570/80968	4152
7590 09/26/2006				
Michael A. Sanzo Fitch, Even, Tabin & Flannery 1801 K Street, N.W., Suite 401L Washington, DC 20006-1201			EXAMINER PARKIN, JEFFREY S	
			ART UNIT 1648	PAPER NUMBER

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/772,089	<b>Applicant(s)</b> FARZAN ET AL.	
	<b>Examiner</b> Jeffrey S. Parkin, Ph.D.	<b>Art Unit</b> 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 01 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### Restriction Requirement

#### 35 U.S.C. § 121

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- a. Group I, claim(s) 1, 2, and 36, drawn to a **peptide** 30 amino acids in length, classified in class 530, subclasses 300 and 324.
- b. Group II, claim(s) 3-5, drawn to a **polynucleotide** encoding a peptide 30 amino acids in length, classified in class 536, subclass 23.1.
- c. Group III, claim(s) 6, 7, and 36, drawn to a **peptide** consisting of **SEQ ID NO.: 1**, classified in class 530, subclass 326.
- d. Group IV, claim(s) 8-10, drawn to a **polynucleotide** encoding a peptide consisting of **SEQ ID NO.: 1**, classified in class 536, subclass 23.1.
- e. Group V, claim(s) 11, 12, and 36, drawn to a **peptide** consisting of **SEQ ID NO.: 2**, classified in class 530, subclass 326.
- f. Group VI, claim(s) 13-15, drawn to a **polynucleotide** encoding a peptide consisting of **SEQ ID NO.: 2**, classified in class 536, subclass 23.1.
- g. Group VII, claim(s) 16, 17, and 36, drawn to a **peptide** consisting of **SEQ ID NO.: 3**, classified in class 530, subclass 326.
- h. Group VIII, claim(s) 18-20, drawn to a **polynucleotide** encoding a peptide consisting of **SEQ ID NO.: 3**, classified in class 536, subclass 23.1.
- i. Group IX, claim(s) 21, 22, and 36, drawn to a **peptide** consisting of **SEQ ID NO.: 4**, classified in class 530, subclass 325.
- j. Group X, claim(s) 23-25, drawn to a **polynucleotide** encoding a peptide consisting of **SEQ ID NO.: 4**, classified in class 536, subclass 23.1.

- k. Group XI, claim(s) 26, 27, and 36, drawn to a **peptide** consisting of **SEQ ID NO.: 5**, classified in class 530, subclass 326.
- l. Group XII, claim(s) 28-30, drawn to a **polynucleotide** encoding a peptide consisting of **SEQ ID NO.: 5**, classified in class 536, subclass 23.1.
- m. Group XIII, claim(s) 31, 32, and 36, drawn to a **peptide** consisting of **SEQ ID NO.: 6**, classified in class 530, subclass 326.
- n. Group XIV, claim(s) 33-35, drawn to a **polynucleotide** encoding a peptide consisting of **SEQ ID NO.: 6**, classified in class 536, subclass 23.1.
- o. Group XV, claim(s) 37, drawn to a **method of preventing HIV gp120-CCR5 binding events** by administering sundry peptides, classified in class 435, subclass 5.
- p. Group XVI, claim(s) 38 and 39, drawn to a **method for increasing antibody binding affinity** through sulfation of tyrosine residues, classified in class 435, subclass 70.1.

Applicants are further advised that if Group I is elected, a single polypeptide (e.g., one of SEQ ID NOS.: 1-6) must also be elected pursuant to 35 U.S.C. § 121. Each polypeptide has a unique structure and function and will necessitate separate searches. The examiner would consider rejoining Group I with one of Groups III, V, VII, IX, XI, and XIII (e.g., if SEQ ID NO.: 1 is elected from Group I, it could be rejoined with Group III). Applicants are reminded that the claims must be amended to reflect the election where appropriate.

Applicants are further advised that if Group XV is elected, a single polypeptide (e.g., one of SEQ ID NOS.: 1-6) must also be elected pursuant to 35 U.S.C. § 121 for use in the claimed method. Each polypeptide has a unique structure and function and will necessitate separate searches. Applicants are reminded that the

claims must be amended to reflect the election where appropriate.

The inventions are distinct, each from the other because of the following reasons:

#### *Unrelated Inventions*

Inventions I-XIV are all unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and § 808.01). In the instant case, each group is directed toward a structurally/functionally different product (e.g., polypeptide or nucleotide sequence) with disparate physicochemical properties. Furthermore, each of the polypeptides identified in Groups I, III, V, VII, IX, XI, and XIII are structurally/functionally unrelated and will require separate searches. Each of the polynucleotides identified in Groups II, IV, VI, VIII, X, XII, and XIV are structurally/functionally unrelated and will also require separate searches.

Inventions II/IV/VI/VIII/X/XII/XIV and XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and § 808.01). In the instant case, the methodology of Group XV neither requires nor utilizes any of the products of Groups II, IV, VI, VIII, X, XII, or XIV.

Inventions I-XV and XVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and § 808.01). In the instant case, the methodology of Group XV neither requires

nor utilizes any of the products of Groups I-XIV. Moreover, the methodology of Group XV is directed toward a different scientific objective and employs unrelated scientific reagents and protocols.

*Product and Process of Using*

Inventions I/III/V/VII/IX/XI/XIII and XV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, each of the identified polypeptides in Groups I, III, V, VII, IX, XI, and XIII can be employed in a number of materially different processes such as the generation of immunological reagents or in affinity purifications schemes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and require separate searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143). Applicant is also advised that the claims should be amended to reflect the election, where necessary.

**37 C.F.R. § 1.48(b)**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

***Claim Rejoinder (M.P.E.P. § 821.04)***

Applicants are reminded that a restriction between product and process claims has been set forth *supra*. When applicant elects claims directed to the product, and a product claim is subsequently found to be allowable, withdrawn process claims that depend from or otherwise include **all** the limitations of the allowable product claim will be rejoined in accordance with the provisions of § 821.04 of the M.P.E.P. Process claims that depend from or otherwise include **all** the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. § 1.116 while amendments submitted after allowance are governed by 37 C.F.R. § 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. § 1.104. Thus, to be allowable, the rejoined claims **must** meet all criteria for patentability as set forth under 35 U.S.C. §§ 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. **Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined.** See AGuidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer*, and 35 U.S.C. §

103(b), 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so will result in a loss of the right to rejoinder.** Furthermore, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. § 804.01.

#### **Correspondence**

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce R. Campell, Ph.D., can be reached at (571) 272-0974. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

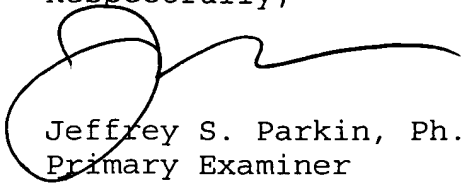
Applicants are reminded that the United States Patent and Trademark Office (Office) requires most patent related correspondence to be: a) faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), b) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 C.F.R. § 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence. For further information refer to the Updated Notice of Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence, and Exceptions Thereto, 1292 Off. Gaz. Pat. Office 186 (March 29, 2005).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status



information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,

A handwritten signature in black ink, appearing to read 'Jeffrey S. Parkin', with a large circular flourish on the left side.

Jeffrey S. Parkin, Ph.D.  
Primary Examiner  
Art Unit 1648

19 September, 2006